

REMARKS

Claims 1-8, 11, 131-133 and 144-149 were pending in the subject application. Claims 131-133 and 146-149 were withdrawn from consideration by the Examiner as drawn to a non-elected invention. By this amendment, Claims 3, 131-133 and 146-149 have been canceled without prejudice or disclaimer, Claim 1 has been amended, and new Claim 150 been added. Accordingly, upon entry of this amendment, Claims 1-2, 4-8, 11, 144-145 and 150 will be pending.

Applicants maintain that the amendments to the claims do not raise an issue of new matter. Support for the amendment to Claim 1 can be found in Claim 3. Support for new Claim 150 can be found in compound 5 of Figure 1. Accordingly, entry of the amendments is respectfully requested.

Rejections under 35 U.S.C. 102/103

Claims 1-8, 11 and 144-145 are rejected under 35 U.S.C. §102(e) as anticipated by or, in the alternative under 35 U.S.C. §103(a) as obvious over, Kao et al. (U.S. Patent No. 6,803,479) ("Kao").

Applicants respectfully traverse these rejections.

Claim 1 has been amended to specify that the caged ligand is a steroid. In contrast, Kao teaches caged non-steroidal compounds (see, for example, STATEMENT OF INVENTION in Column 1). As indicated by the Examiner, Kao does mention steroids, but, as discussed below, this is in the context of teaching away from using steroids as caged compounds.

First, it should be noted that Kao has extensive experience with producing caged compounds. As indicated in Column 2, lines 25-27, "Our laboratory has been designing, synthesizing caged molecules, as well as developing their applications in biological systems for over ten years."

In Column 13, Kao discusses the possibility of caging the steroid mifepristone, an idea that Kao rejects. Kao notes "Our somewhat limited experience with bioactive steroids, however, is that they are prone to side reactions, and chemical manipulations

often require extensive use of protective groups to block such unwanted reactions. As a starting point for testing the concept of a photochemical gene switch, steroid-based inducers may prove intractable.” (See Column 13, lines 22-28.)

Similarly, in Column 15, Kao rejects the idea of using the steroids ponasterone A and muristerone A to prepare caged compounds. Kao notes at lines 11-13 “That these ecdysone analogues are steroids presents the same chemical obstacle to caging as did mifepristone.”

In contrast, in the present invention, the inventors developed a chemical strategy for successfully caging steroids as exemplified, e.g., on pages 23-24 and 28 of the present application.

Accordingly, applicants maintain that Kao does not anticipate or render obvious the invention set forth in the pending claims, and reconsideration and withdrawal of these rejections are respectfully requested.

Application No.: 10/532,009
Applicants: David Lawrence et al.
Filed: November 16, 2005

CONCLUSIONS

In view of the preceding amendments and remarks, applicants respectfully request that the Examiner reconsider and withdraw the rejections set forth in the October 27, 2009 Office Action, and earnestly solicit allowance of the pending claims. If there is any minor matter preventing the allowance of the subject application, the Examiner is requested to telephone the undersigned attorney.

No fee is deemed necessary in connection with the filing of this Amendment. However, if any other fee is required with this reply or to maintain the pendency of the subject application, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 01-1785.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN LLP
Attorneys for Applicants
90 Park Avenue
New York, New York 10016
(212) 336-8000

Dated: January 13, 2010
New York, New York

By


Alan D. Miller, Reg. No. 42,889